

REMARKS

Amendments to the Specification

Paragraph [0012] has been amended to delete a redundant component.

As requested by the Examiner, paragraph [0076] has been amended to delete the attorney docket number and insert an application serial number.

Support for Claim Amendments

Claims 1, 29, and 31 have been amended to recite that the hydrogenated block copolymer comprises a styrene-(ethylene-butylene)-styrene triblock copolymer. Support for these amendments may be found in Claim 12 as filed.

Claim 11 has been amended to correct the structure of the alkenyl aromatic compound. Support for this amendment may be found in paragraph [0030] of the application as filed.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claim 31 stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art to which it pertains, or with which it was most nearly connected, to make and/or use the invention. Specifically, the specification as filed allegedly does not disclose how to make the “reaction product” of claim 31. (Paper 7, page 2, first paragraph.) Applicants respectfully traverse this rejection.

A claim is enabled for the purposes of 35 U.S.C. § 112, first paragraph if the specification teaches “those in the art to make and use the invention without undue experimentation.” *In re Wands*, 858 F.2d 731, 737 (1988). Claim 31 is enabled because the specification teaches those skilled in the art to use the corresponding inventions without any additional experimentation. Applicants note, first, that that starting material

comprising reaction products of compositions such as those in Claim 1 are expressly mentioned at paragraph [0012] of the specification as filed. Applicants further note that a method for forming such articles is taught at paragraph [0082]. Finally, applicants note that those skilled in the art will appreciate that "reaction products" refers to the possibility that one or more starting material components in the composition may chemically react during compounding and/or subsequent processing required to form an article (e.g., injection molding). For example, an amine-substituted carbon on a polyphenylene ether may undergo deamination and react with a pendant double bond of a styrene-butadiene-styrene block copolymer. Because such reaction products may be formed during processing, the processing methods described in paragraphs [0070], [0071], [0080], and [0081] (blending and extrusion), and [0082] (article formation) of the specification serve as methods for the preparation of reaction products. The specification therefore provides the compositions and methods necessary to form the reaction products, and no additional experimentation would be necessary for one skilled in the art to practice the inventions of Claim 31. Accordingly, Applicants request the reconsideration and withdrawal of the rejection of Claim 31 under 35 U.S.C. §112, first paragraph.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-36 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse these rejections.

Claim 3 was rejected because the term "substantially free" is allegedly subjective as to how much substantially would embrace. (Paper 7, page 2, paragraph 3.) Applicants respectfully note that the term "substantially free" does not appear directly in claim 3, but it does appear in claims 1, 22, and 29-31. The Federal Circuit has recently reiterated that the term "substantially" is commonly used in patent claims and is not indefinite when it "serves reasonably to describe the subject matter so that its scope would be understood by

is also well established that claims must be interpreted in light of the specification and given their broadest possible interpretation. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). Applicants respectfully assert that there is no ambiguity in the term "substantially free" in claims 1 and 29-31 because a composition "substantially free of rubber-modified poly(alkenyl aromatic) resin" is most broadly defined in paragraph [0062] as comprising less than 0.5 weight percent of the total composition. Applicants also respectfully assert that there is no ambiguity in the term "substantially free" in claim 22 because a composition "substantially free of reinforcing fillers" is most broadly defined in paragraph [0066] as comprising less than 0.5 weight percent of reinforcing fillers. Claims 1, 22, and 29-31 are therefore not indefinite.

Claim 11 was rejected as unclear based on the term "naphthyl group including." (Paper 7, page 2, paragraph 4.) Claim 11 has been amended to delete the offending word "including."

In view of the above remarks, Applicants request the reconsideration and withdrawal of the rejection of claims 1-36 under 28 U.S.C. §112, second paragraph

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-46 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 5,081,187 to Maruyama. Applicants respectfully traverse this rejection.

U.S. Patent No. 5,081,187 to Maruyama et al. ("Maruyama"), generally describes a composition comprising (a) 20-95 weight percent polyolefin, (b) 5-80 weight percent polyphenylene ether, (c) 2-45 parts by weight per 100 parts by weight (a)+(b) of a partially hydrogenated alkenyl aromatic compound-isoprene block copolymer, and (d) 3-45 parts by weight per 100 parts by weight (a)+(b) of an alkenyl aromatic compound-conjugated diene block copolymer (abstract).

Maruyama teaches a composition comprising (a) 20 to 95 weight percent of a homopolymer of an alkenyl aromatic monomer; about 10 to about 35 weight percent of a

polyolefin; about 1 to about 15 weight percent of a hydrogenated block copolymer of alkenyl aromatic compound and a conjugated diene having an alkenyl aromatic content of 40 to about 90 weight percent, and wherein the hydrogenated block copolymer comprises a styrene-(ethylene-butylene)-styrene triblock copolymer; and about 1 to about 15 weight percent of an unhydrogenated block copolymer of alkenyl aromatic compound and a conjugated diene; wherein the composition is substantially free of rubber-modified poly(alkenyl aromatic) resin; and wherein all weight percents are based on the total weight of the composition.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A 1970).

All of Applicants' independent claims currently require the presence of a hydrogenated block copolymer that comprises a styrene-(ethylene-butylene)-styrene triblock copolymer. Such triblock copolymers are not taught in Maruyama. To the extent that Maruyama discloses hydrogenated styrene-butadiene block copolymers, such copolymers are described as inferior to Maruyama's required partially hydrogenated alkenyl aromatic compound-isoprene block copolymer (c. 7, ll. 4-14; c. 10, ll. 41-58, Table 1). Maruyama thus fails to disclose Applicants' styrene-(ethylene-butylene)-styrene triblock copolymer, and Maruyama generally teaches away from the use of the hydrogenated styrene-butadiene block copolymers. Accordingly, a prima facie case of obviousness has not been established, and all claims are patentable over Maruyama.

Applicants also note that Claims 22-25 are further patentable over Maruyama because Maruyama contains no specific suggestion to use a polypropylene-polystyrene graft copolymer. To the extent that such a copolymer could have been selected from among myriad "copolymers such as random, block, and graft copolymers of a

suggestion. *In re Dow Chemical Co.*, 5 U.S.P.Q.2d 1529, 1532 (Fed. Cir. 1988)(rejecting the “obvious to experiment” standard of obviousness, and stating that “selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings”).

Because Maruyama does not disclose all elements of Applicants’ claims, a prima facie case of obviousness has not been established against any of these claims. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 1-36 under 28 U.S.C. §103(a) over Maruyama.

Provisional Obviousness-Type Double Patenting Rejections

Claims 1-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-21 and 23-43 of copending application Serial No. 09/682,926. Applicants are submitting herewith a terminal disclaimer in compliance with 37 CFR § 1.321(c) to overcome the rejection.

Claims 1-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-46 of copending application Serial No. 09/682,921. Applicants are submitting herewith a terminal disclaimer in compliance with 37 CFR § 1.321(c) to overcome the rejection.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0862 maintained by Assignee.

Respectfully submitted,

CANTOR COLBURN LLP
Applicants' Attorneys

By: _____

J. Michael Buchanan

Registration No. 44,571

Date: April 11, 2003
Customer No.: 23413
Telephone: (860) 286-2929